

No. 78-454

Supreme Court, U. S.

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**In the Supreme Court of the United States**

OCTOBER TERM, 1978

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**VLADIMIR HENRY PAVLECKA and  
JOHN PAVLECKA, PETITIONERS**

v.

**DONALD W. BANNER, COMMISSIONER OF PATENTS AND  
TRADEMARKS**

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***ON PETITION FOR A WRIT OF CERTIORARI TO  
THE UNITED STATES COURT OF CUSTOMS AND  
PATENT APPEALS***

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**MEMORANDUM FOR THE RESPONDENT  
IN OPPOSITION**

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**WADE H. MCCREE, JR.**  
*Solicitor General  
Department of Justice  
Washington, D.C. 20530*

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Petitioners contend that the Patent and Trademark Office should not have restricted the claims presented in their patent application.

1. Petitioners filed with the Commissioner of Patents and Trademarks a patent application entitled "Resilient Annular Coupling" (Pet. 6). Their application described several different kinds of coupling devices. These devices are intended to connect concentrically arranged elements, such as a shaft and a rotor, through use of resilient members (Pet. App. A-18 to A-19). The resilient members would expand and contract when subjected to axial pressure, thus frictionally engaging and disengaging the inner and outer elements (Tr. 18-19).<sup>1</sup>

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<sup>1</sup>"Tr." refers to the transcript of record in the United States Court of Customs and Patent Appeals.

The Patent and Trademark Office examiner determined that claims to more than one independent and distinct invention had been presented in the application, and he required petitioners to elect a single species of their invention for consideration in their present patent application.<sup>2</sup> Petitioners objected to the examiner's requirement but nonetheless elected a species of their invention (Tr. 26-33). The examiner thereafter determined that all claims not relating to the species that had been elected would be "withdrawn from further consideration in this case" pursuant to 37 C.F.R. 1.142(b) (Tr. 37-38).

Petitioners challenged the examiner's restriction requirement and subsequent withdrawal of claims by petition to the Commissioner (Tr. 38). The Commissioner sustained the restriction requirement but directed the examiner to reject any claims that did not relate to the elected species so that the correctness of that determination could be appealed (Tr. 55-56). The examiner then rejected those claims that did not properly relate to the elected species, and the Patent and Trademark Office Board of Appeals affirmed his rejection. The Board of Appeals expressly declined to review the propriety of the

<sup>2</sup>The statutory authority for the examiner's requirement is 35 U.S.C. 121, which provides in pertinent part:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application \* \* \* it shall be entitled to the benefit of the filing date of the original application.

The statute is implemented by Patent and Trademark Office regulations, 37 C.F.R. 1.141 *et seq.* (Pet. App. A-15 to A-17). Under 37 C.F.R. 1.142, an inventor presenting two or more separate inventions in a single application is required to elect the invention to be prosecuted.

underlying restriction requirement that had previously been approved by the Commissioner, noting that it had no jurisdiction to do so (Pet. App. A-8 to A-13). The Court of Customs and Patent Appeals affirmed, stating that "the sole issue on this appeal is whether the rejected claims read on [properly relate to] the elected species" (Pet. App. A-1, A-2).

2. As petitioners correctly state (Pet. 13), the eight claims that are involved in this case have not been rejected on their merits.<sup>3</sup> In addition, as petitioners concede (Pet. 13), those eight claims do not "read on" the elected species that is now being processed. Petitioners nonetheless contend that the claims that have been removed from consideration have been wrongfully appropriated or given to the public (Pet. 3, 11, 21, 22). Petitioners are plainly wrong, for the eliminated claims are still subject to consideration on their merits by the Patent and Trademark Office and may yet be determined to be patentable. Such further consideration can be obtained by petitioners by filing one or more appropriate divisional patent applications, thus following the procedure spelled out in 35 U.S.C. 121 (see note 2, *supra*). As the Court of Customs and Patent Appeals explained:

The rejection goes only to [petitioners'] right to prosecute the rejected claims *in this application* in view of their election in compliance with the examiner's requirement under 37 C.F.R. 1.141.

Pet. App. A-2 to A-3 (emphasis added). The court's affirmance of the rejection of certain of petitioners' claims does not in any way prejudice or foreclose petitioners' right to consideration of those claims once they have been properly presented. See *In re Hengehold*, 440 F. 2d 1395,

<sup>3</sup>At the present time, some of petitioners' claims have been found to be allowable by the examiner (Tr. 38, 100), or have been reinstated for consideration by the Board of Appeals (Pet. App. A-13). As stated in the petition, of the 27 claims originally filed in the application, only eight have been removed from consideration (Pet. 8).

1403 n.11 (C.C.P.A. 1971); see also *In re Pavlecka*, 319 F. 2d 180, 185 (C.C.P.A. 1963), where the court previously explained to petitioner John Pavlecka:

The significance of the rejection of [certain] claims \* \* \* appears to be misunderstood by appellant who refers to such rejection as "a devious act because it fails to state that the rejection is actually on the merits \* \* \*." [But] "the rejection of these claims as not readable on the elected species is not a rejection on the merits but rather a refusal by the examiner to consider them on the merits in this application."

Petitioners' attack on the underlying requirement of the Commissioner restricting them to a single species of invention is not properly raised in this Court. The court below correctly declined to review that question, noting (Pet. App. A-3):

We are, moreover, not reviewing the restriction requirement itself. [Petitioners] had "their day in court" on that issue by their petition to the Commissioner, which was decided against them. That decision is not appealable here.

As the court pointed out in *In re Hengehold, supra*, 440 F. 2d at 1398-1404, review of discretionary decisions by the Commissioner restricting claims presented in a single application must be sought under the Administrative Procedure Act, 5 U.S.C. 701 *et seq.*, and cannot be obtained through the Board of Appeals and the Court of Customs and Patent Appeals. Petitioners could have sought judicial review of the Commissioner's restriction requirement, but they failed to do so. In any event, it is plain that 35 U.S.C. 121 authorizes the Commissioner to sever distinct and independent inventions. The application of that clear statutory authority to the particular facts of this case presents no question warranting this Court's review.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.  
Solicitor General

NOVEMBER 1978